UNITED STATES PATENT AND TRADEMARK OFFICE

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09/842,219	04/26/2001	Shunpei Yamazaki	12732-032001 / US4867	5375

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EXAMINER
HENNING, MATTHEW T

ART UNIT	PAPER NUMBER
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NOTIFICATION DATE	DELIVERY MODE
11/13/2008	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>06 October 2008</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1,26,51,54-60 and 62-95</u> is/are pending in the application.

  4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1,26,51,54-60 and 62-95</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>26 April 2001</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

  Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

  Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

  a)☒ All   b)☐ Some * c)☐ None of:

    1.☒ Certified copies of the priority documents have been received.

    2.☐ Certified copies of the priority documents have been received in Application No. _____.

    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

  * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

1   This action is in response to the communication filed on 10/6/2008.

2   **DETAILED ACTION**

3   *Continued Examination Under 37 CFR 1.114*

4   A request for continued examination under 37 CFR 1.114, including the fee set forth in

5   37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

6   eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

7   has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

8   37 CFR 1.114. Applicant's submission filed on 10/6/2008 has been entered.

9

10   *Response to Arguments*

11   Applicants' arguments filed 10/6/2008 have been fully considered but the examiner does

12   not find the arguments persuasive.

13   Regarding the applicants' argument that Li failed to disclose "checking...without a

14   necessity of a communication between the portable communication device and the server", the

15   examiner does not find the argument persuasive. In Li, the checking is performed in the phone.

16   Checking requires nothing more than a comparison. In this case, Li compares the captured

17   fingerprint a previously received fingerprint. However, the comparison does not require any

18   communication as the comparison is performed inside the phone. As such, the examiner does

19   not find the argument persuasive.

20   Regarding applicants' argument that Li failed to disclose the limitation that "[the]

21   checking the read biological information with the stored biological information is carried out by

22   using only the checking circuit in the portable communication device", the examiner does not

1   find the argument persuasive. The checking, as claimed, has been interpreted as the comparison

2   between the read and the stored biological information. In Li, this comparison is performed by

3   the CPU 401, as can be seen in Col. 12 Lines 8-36 of Li. "FCPD 101 also includes a CPU

4   (central processing unit) 401 that can supply...all processing of fingerprint images and their

5   subsequent comparison". This is what reads on the checking and as such meets the limitations of

6   the claim. As such, the examiner does not find the argument persuasive.

7   Regarding applicants' argument that Li did not disclose a "personal identification

8   number", the examiner does not find the argument persuasive. The examiner has looked to the

9   instant specification for guidance as to what the applicants intend to encompassed by the term

10   "personal identification number", however, no explanation of this terminology has been

11   provided. As such, the examiner has interpreted this limitation as reading on any number which

12   provides identification of a person. Based upon this interpretation, there are numerous ways in

13   which Li provides disclosure of personal identification numbers.

14   One way the fingerprint password reads on a personal identification number is based

15   upon the underlying nature of how computers operate. Computers operate on data which is

16   represented as binary numbers. As such, when the user in Li provides a fingerprint, that

17   fingerprint is converted into a binary number. This binary number, which represents the

18   fingerprint, is then used to identify the user, and as such reads on a personal identification

19   number.

20   Another way the fingerprint password reads on a personal identification number is that Li

21   disclosed that the fingerprints are converted into tokens. Fig. 2 Elements 202 and 204 provide

1   showing that the tokens are numbers. The tokens are also used to identify the user, and as such

2   read on a personal identification number.

3   As can be seen, Li did, in fact, disclose the user of a personal identification number. As

4   such, the examiner does not find the argument persuasive.

5   Regarding the applicants' allegation that while Li may have disclosed a "PIN", the

6   examiner has ignored "a particular process for using a PIN", the examiner does not find the

7   argument persuasive. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they

8   amount to a general allegation that the claims define a patentable invention without specifically

9   pointing out how the language of the claims patentably distinguishes them from the references.

10   As such, the examiner does not find the argument persuasive.

11   Claims 1, 26, 51, 54-60, and 62-95 have been examined. Claims 2-25, 27-50, 52-53, and

12   61 have been cancelled.

13   All objections and rejections not set forth below have been withdrawn.

14

15

16   ***Claim Rejections - 35 USC § 102***

17   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

18   basis for the rejections under this section made in this Office action:

19   A person shall be entitled to a patent unless –

20   (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
21   in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
22   patent by another filed in the United States before the invention by the applicant for patent, except that an
23   international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
24   subsection of an application filed in the United States only if the international application designated the United
25   States and was published under Article 21(2) of such treaty in the English language.
26

1   Claims 84-85, 93, and 95 are rejected under 35 U.S.C. 102(e) as being anticipated by Li

2 et al. (US Patent Number 6,219,793) hereinafter referred to as Li.

3   Li disclosed a system for identifying an individual to identify a client, said system

4 comprising: a storing means for storing the biological information of the client (See Li Fig. 4

5 Element 404, Col. 10 Lines 57-65 and Col. 12 Lines 20-27); a reading means for reading the

6 biological information of the client (See Li Fig. 4 Element 417); a checking means for checking

7 the read biological information with the stored biological information without the necessity of a

8 communication between the portable communication device and the server (See Li Fig. 4

9 Element 401 and Col. 12 Lines 8-36); and a transmitting means for transmitting information to

10 the server that the checking has matched (See Li Fig. 4 Elements 402 and 102 and Col. 11 Lines

11 3-9), wherein checking the read biological information with the stored biological information is

12 carried out by using only the portable communication device (See Li Col. 12 Lines 12-17).

13   ***Claim Rejections - 35 USC § 103***

14   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

15 obviousness rejections set forth in this Office action:

16   (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
17   section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
18   such that the subject matter as a whole would have been obvious at the time the invention was made to a person
19   having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
20   manner in which the invention was made.

21

22   Claims 92, and 94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li et

23 al. (US Patent Number 6,219,793) hereinafter referred to as Li.

24   Li disclosed providing a personal identification number to the phone but failed to

25 specifically disclose that in a case that the personal identification number matches with a number

26 stored at the server the stored biological information can be rewritten.

1   However, it would have been obvious to the ordinary person skilled in the art that in the

2   case that the master user's personal identification number information matched a number stored

3   at the server that the stored biological information could be rewritten. This would have been

4   obvious <u>because</u> the ordinary person skilled in the art would have been motivated to allow an

5   authorized user (a user who's fingerprint matches the master users fingerprint) to update the

6   biological information.

7

8   Claims 1, 26, 51, 54-60, 62-83, and 86-91 are rejected under 35 U.S.C. 103(a) as being

9   unpatentable over Li et al. (US Patent Number 6,219,793) hereinafter referred to as Li, and

10   further in view of Nagayoshi et al. (US Patent Number 6,839,798) hereinafter referred to as

11   Nagayoshi.

12   Regarding claims 1 and 26, Li disclosed a system for identifying a client (See Li

13   Abstract), the system comprising a server and a portable communication device, wherein the

14   portable communication device comprises: a memory for storing at least one reference biological

15   information of the client using the portable communication device (See Li Fig. 4 Element 404,

16   Col. 10 Lines 57-65 and Col. 12 Lines 20-27); a sensor for reading at least one biological

17   information of the client (See Li Fig. 4 Element 417); a checking circuit for checking the read

18   biological information with the stored biological information without the necessity of a

19   communication between the portable communication device and the server (See Li Fig. 4

20   Element 401 and Col. 12 Lines 8-36); and a transmitting circuit for transmitting information that

21   the read biological information and the stored biological information have matched to the server

22   in a case where the checking has matched (See Li Fig. 4 Elements 402 and 102 and Col. 11 Lines

1   3-9), wherein the server is configured to transmit the information that the read biological

2   information and the stored biological information have matched to a final end of transaction

3   configured to start a transaction with the client conditioned upon receipt of the information that

4   the read biological information and the stored biological information have matched (See Li Col.

5   16 Paragraph 2), but failed to specifically disclose that memory 404 was a nonvolatile memory.

6   However, Li did disclose that the portable communication device could be a phone (See

7   Li Fig. 1), and that the memory 404 stored at least those items necessary to the operation of the

8   fingerprint capturing device including program code for processing, as well as temporary data

9   (See Li Col. 12 Lines 20-27), and Li further disclosed the use of "routine present-day calling

10   protocol to complete the connection" once the connection was authorized.

11   Nagayoshi teaches a flash memory device, which can be used in a mobile phone (See

12   Nagayoshi Col. 1 Lines 12-18 and Col. 3 Lines 43-46), for storing nonvolatile data such as

13   rewritten data (See Nagayoshi Col. 1 Lines 60-64) as well as program data (See Nagayoshi Col.

14   1 Lines 6-18).

15   It would have been obvious to the ordinary person skilled in the art at the time of

16   invention to employ the teaching of Nagayoshi in the mobile phone system of Li by using the

17   flash memory of Nagayoshi as the memory 404 in Li. This would have been obvious because

18   the ordinary person skilled in the art would have been motivated to provide the needed memory

19   to Li in a small packaging area at a small cost.

20   Regarding claim 51, Li disclosed a business method using the Internet, said business

21   method comprising: identifying a client by an identifying element loaded in a portable

22   communication device (See Li Fig. 1 Elements 101, 102, and 112 and Fig. 4); and controlling a

1   communication between the client and a plurality of dealers (See Li Fig. 2 Element 202) by a

2   control element in a server (See Li Abstract, and Figs. 3A and 3B); wherein said identifying

3   comprises: storing a reference biological information of the client in a memory in the portable

4   communication device (See Li Fig. 4 Element 404 and Col. 10 Lines 57-65 and Col. 12 Lines

5   20-27); reading biological information of the client (See Li. Col. 10 Lines 57-58); checking the

6   read biological information with the reference biological information without the necessity of a

7   communication between the portable communication device and the server (See Li Col. 10 Lines

8   61-65); and transmitting information that the read biological information and the reference

9   biological information have matched from the identifying element to the control element in a

10   case where the checking has matched (See Li Fig. 4 Elements 402 and 102 and Col. 11 Lines 3-

11   9), and wherein said controlling step comprises: admitting the communication between the client

12   and the plurality of dealers after identifying the client by the identifying element (See Li Col. 11

13   Lines 19-60); and providing a password to the client (See Li Col. 10 Lines 48-56), and wherein

14   the server is configured to transmit the information that the read biological information and the

15   stored biological information have matched to a final end of transaction configured to start a

16   transaction with the client conditioned upon receipt of the information that the read biological

17   information and the stored biological information have matched (See Li Col. 16 Paragraph 2),

18   but failed to specifically disclose that memory 404 was a nonvolatile memory.

19   However, Li did disclose that the portable communication device could be a phone (See

20   Li Fig. 1), and that the memory 404 stored at least those items necessary to the operation of the

21   fingerprint capturing device including program code for processing, as well as temporary data (

1   See Li Col. 12 Lines 20-27), and Li further disclosed the use of "routine present-day calling

2   protocol to complete the connection" once the connection was authorized.

3   Nagayoshi teaches a flash memory device, which can be used in a mobile phone (See

4   Nagayoshi Col. 1 Lines 12-18 and Col. 3 Lines 43-46), for storing nonvolatile data such as

5   rewritten data (See Nagayoshi Col. 1 Lines 60-64) as well as program data (See Nagayoshi Col.

6   1 Lines 6-18).

7   It would have been obvious to the ordinary person skilled in the art at the time of

8   invention to employ the teaching of Nagayoshi in the mobile phone system of Li by using the

9   flash memory of Nagayoshi as the memory 404 in Li. This would have been obvious <u>because</u>

10 the ordinary person skilled in the art would have been motivated to provide the needed memory

11 to Li in a small packaging area at a small cost.

12

13   Regarding claim 83, Li disclosed a system for identifying a client, said system

14 comprising: a server (See Li Fig. 1 Element 106); a storing means comprising memory for

15 storing reference biological information of the client (See Li Fig. 4 Element 404); a reading

16 means for reading biological information of the client (See Li Fig. 4 Element 101); a checking

17 means for checking the read biological information with the reference biological information

18 without the necessity of a communication between the portable communication device and the

19 server (See Li Col. 10 Lines 61-65); a transmitting means for transmitting information that the

20 read biological information and the reference biological information have matched to the server

21 in a case where the checking has matched (See Li Fig. 4 Elements 402 and 102 and Col. 11 Lines

22 3-9); a final end of transaction (See Li Fig. 3B Step 319 Recipient and Col. 16 Paragraph 2); a

1   further transmitting means for transmitting said information that the read biological information

2   and the reference biological information have matched from the server to the final end of

3   transaction with the client (See Li Fig. 3B Step 319 and Col. 16 Paragraph 2); and a transaction

4   starting means for starting a transaction between the client and the final end of transaction after

5   the final end of transaction has received said information that the read biological information and

6   the reference biological information have matched (See Li Fig. 3B Steps 316 and 319 and Col.

7   16 Paragraph 2), but failed to specifically disclose that memory 404 was a nonvolatile memory.

8   However, Li did disclose that the portable communication device could be a phone (See

9   Li Fig. 1), and that the memory 404 stored at least those items necessary to the operation of the

10 fingerprint capturing device including program code for processing, as well as temporary data (

11 See Li Col. 12 Lines 20-27), and Li further disclosed the use of "routine present-day calling

12 protocol to complete the connection" once the connection was authorized.

13   Nagayoshi teaches a flash memory device, which can be used in a mobile phone (See

14 Nagayoshi Col. 1 Lines 12-18 and Col. 3 Lines 43-46), for storing nonvolatile data such as

15 rewritten data (See Nagayoshi Col. 1 Lines 60-64) as well as program data (See Nagayoshi Col.

16 1 Lines 6-18).

17   It would have been obvious to the ordinary person skilled in the art at the time of

18 invention to employ the teaching of Nagayoshi in the mobile phone system of Li by using the

19 flash memory of Nagayoshi as the memory 404 in Li. This would have been obvious because

20 the ordinary person skilled in the art would have been motivated to provide the needed memory

21 to Li in a small packaging area at a small cost.

1   Regarding claims 54 and 66, Li, and Nagayoshi, disclosed that the nonvolatile memory

2   stores a plurality of biological information of the client (See Li Col. 15 Paragraph 3 and Col. 3

3   Paragraph 3 and Col. 10 Paragraph 4), and the transmitting circuit transmits information that the

4   read biological information has matched with at least one of the stored plurality of information to

5   the server (See Li Col. 11 Lines 3-9).

6   Regarding claims 55 and 67, Li, and Nagayoshi disclosed that the sensor reads a plurality

7   of biological information of the client (See Li Col. 15 Paragraph 4), and the transmitting circuit

8   transmits information that each of the plurality of read biological information has matched with

9   at least one of the plurality of stored biological information (See Li Col. 11 Lines 3-9).

10   Regarding claims 56 and 68, Li, and Nagayoshi disclosed that the information that the

11 read biological information and the stored biological information have matched is transmitted to

12 the server through the Internet (See Li Col. 7 Paragraph 2).

13   Regarding claims 57 and 71, Li, and Nagayoshi disclosed that after transmitting

14 information that the checking has matched to the server, a personal identification number

15 information is sent to the Server (See Li Col. 15 Paragraphs 3-4).

16   Regarding claims 58 and 72, Li, and Nagayoshi disclosed that in a case that the personal

17 identification number matches with a number stored at the server, the stored biological

18 information is rewritable (See Li Col. 15 Paragraph 3).

19   Regarding claims 59-60, 73-74, and 78-79, Li, and Nagayoshi disclosed that the

20 biological information is one selected from the group consisting of a fingerprint, a palm pattern

21 and a voice print; and that the palm pattern is a whole pattern of the palm or a pattern of a part of

22 the palm (See Li Col. 6 Paragraph 3 and Col. 17 Paragraph 3).

1   Regarding claim 62, Li, and Nagayoshi disclosed that the sensor includes one of a

2   photodiode and a CCD (See Li Col. 4 Paragraph 6).

3   Regarding claims 63-65, 75-77, and 80-82, Li, and Nagayoshi disclosed that the portable

4   communication device comprises a portable information terminal; a portable telephone; a

5   personal computer (See Li Col. 5 Line 66 – Col. 6 Line 14).

6   Regarding claims 69-70, Li, and Nagayoshi disclosed a step of transmitting information

7   that the checking has matched from the server to a connection of the client; and that a transaction

8   is started between the client and the connection after the connection has received information

9   that the checking has matched (See Li Col. 16 Paragraph 2).

10   Regarding claims 86, 87, 89, and 91, Li and Nagayoshi disclosed that checking the read

11   biological information with the stored biological information is carried out by using only the

12   checking circuit in the portable communication device (See Li Col. 12 Lines 12-17).

13   Regarding claims 88, and 90, see the rejection of claims 92 and 94 above.

14   ***Conclusion***

15   Claims 1, 26, 51, 54-60, and 62-95 have been rejected.

16   Any inquiry concerning this communication or earlier communications from the

17   examiner should be directed to MATTHEW T. HENNING whose telephone number is

18   (571)272-3790. The examiner can normally be reached on M-F 8-4.

19   If attempts to reach the examiner by telephone are unsuccessful, the examiner's

20   supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the

21   organization where this application or proceeding is assigned is 571-273-8300.

1   Information regarding the status of an application may be obtained from the Patent

2   Application Information Retrieval (PAIR) system. Status information for published applications

3   may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

4   applications is available through Private PAIR only. For more information about the PAIR

5   system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

6   system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

7   like assistance from a USPTO Customer Service Representative or access to the automated

8   information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

9

10
11   /Matthew T Henning/
12   Examiner, Art Unit 2431
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14
15
16   /Christopher A. Revak/
17   Primary Examiner, Art Unit 2431